

REMARKS

This amendment is being filed in response to the Office Action having a mailing date of October 6, 2006. Claims 1, 12, 18-19, and 21 are amended as shown. No new matter has been added. With this amendment, claims 1-27 are pending in the application.

I. Discussion of the claims and cited references

The present Office Action rejected claims 1-12 and 16-27 under 35 U.S.C. § 103(a) as being unpatentable over Kenny (U.S. Patent Application Publication No. 2004/0036595) in view of Schuermann (EP Application Publication No. 0689161). Claims 13-15 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Kenny in view of Schuermann and further in view of Turner (EP Application Publication No. 0899677). For the reasons set forth below, these rejections are respectfully traversed herein.

A. Discussion of independent claim 1

Independent claim 1 as presently amended recites, *inter alia*, “wherein t_j and t_{j+1} are time intervals of different lengths and wherein the corresponding frequencies f_j and f_{j+1} are different frequencies.” It is respectfully submitted that none of the references, whether singly or in combination, discloses, teaches, or suggests these features.

For example, page 3 of the present Office Action admitted that “Kenny et al. is however silent on teaching the power is transmitted for different time duration.” To supply the missing teachings of Kenny, the present Office Action has cited Schuermann. However, it is respectfully submitted that Schuermann does not cure the deficiencies of Kenny.

For example, the Abstract of Schuermann describes a technique in which the “read range can be varied by varying either the amplitude or duration of the interrogation signal.” That is, Schuermann is concerned specifically about varying the read range by changing the amplitude or duration of the interrogation signal, and is completely silent with regards to providing the interrogation signal with different frequencies. Indeed, it appears that Schuermann provides his interrogations signal with a constant or same frequency, as explained below.

First, Schuermann provides a reader 12 having a reader antenna 14 and a transponder 10 having a transponder antenna 18. Figures 5-7 of Schuermann then show a plurality of items having such transponders 10 affixed thereon. Schuermann explains that the “antennas 14 and 18 are tuned to the same frequency.” *See, e.g.*, column 4, lines 50-51 of Schuermann (emphasis ours). Thus, since all of the transponders 10 of Schuermann have antennas 18 that are tuned to the same frequency as the antenna 14 of his reader 12, the antenna 14 of his reader 12 cannot output different frequencies to read these transponders 10.

The requirement of Schuermann’s antenna 14 to output an interrogation signal having a constant/same frequency is due to the nature of his interrogation technique. That is, Schuermann explains the following on column 6, lines 45-50 (emphasis ours):

“When two transponders are both in field (*i.e.*, within range to be read by reader 12), both will return a signal. If one of these signals is slightly stronger, the reader 12 will read the dominating signal and suppress the slightly weaker signal.”

Thus, Schuermann provides a technique to identify/differentiate between two transponders based on the strength of their response signals, which are sent in response to a common interrogation signal from the reader 12. It is inherent therefore that these two transponders need to be responsive to a common interrogation signal having a same/constant frequency, so that each transponder can recognize and respond to the interrogation signal. Schuermann differentiates between the responsive transponders by varying the read range of the interrogation signal, starting from interrogations at high-medium range and then followed by interrogations at low range. *See, e.g.*, column 6, lines 55-57 of Schuermann. The various transponders will have different response signal strengths at these different interrogation ranges, thereby providing differentiation between them.

Accordingly, Schuermann cannot meet the limitations of claim 1 that require “wherein t_j and t_{j+1} are time intervals of different lengths and wherein the corresponding frequencies f_j and f_{j+1} are different frequencies.” Thus, claim 1 is allowable over Schuermann.

From the above, it is clear that there is no showing that the references, if combined, would meet the limitations of claim 1. It is also respectfully submitted that there is no showing that the reference(s) provide the teaching or motivation to combine references in the first place; and/or no showing that the claimed limitations are found in the individual references. For instance, Schuermann is directed towards a transponder identification technique that is based on being able to change a range of an interrogation signal by changing the duration or amplitude of the interrogation signal, while keeping the frequency of the interrogation signal constant, so as to differentiate response signal strengths. In comparison, Kenny uses a different technique in which tags located in different numbered zones are identified using “triangulation.” *See, e.g.*, line 6 in paragraph [0008] and paragraph [0007] of Kenny. A person skilled in the art would not be motivated to combine the two different techniques of Schuermann and Kenny to arrive at the limitations of claim 1.

It is therefore noted here for the record that the Office Action appears to be trying to use the claimed invention as a blueprint to combine various features of the prior art to arrive at the claimed subject matter. It is well settled that such use of hindsight is impermissible as a matter of law. *In re Gorman*, 18 U.S.P.Q.2d 1885, 1888 (Fed. Cir. 1991). It is the prior art references themselves that must suggest the combination. *Kimberly Clark v. J & J*, 223 U.S.P.Q. 603 (Fed. Cir. 1984). *See also* *Fromson v. Advanced Offset Plate*, 755 F.2d 1549, 1556 (Fed. Cir. 1985). The cited references, as explained above, clearly do not teach or suggest sending powers of different durations and different frequencies.

Moreover, it is noted that Kenny provides a technique that uses different frequencies (but does not provide different durations as recited in claim 1), whereas Schuermann provides the same/constant frequency. These are clearly inconsistent/incompatible techniques that teach away from combining the two references. The Examiner *must* take the references in their entirety, and cannot simply ignore portions that *teach away* from the claimed subject matter or otherwise argue against obviousness. *Bausch & Lomb v. Barnes-Hind/Hydrocurve, Inc.*, 230 U.S.P.Q. 416, 420 (Fed. Cir. 1986). It is impermissible to pick and choose from a reference only so much of it as will support a conclusion of obviousness to the exclusion of other parts necessary to a full appreciation of what the reference fairly suggests to one skilled in the art. *Id*

at 419. The courts have long cautioned that consideration *must* be given “where the references diverge and *teach away* from the claimed invention.” *Akzo N.V. v. International Trade Commission*, 1 U.S.P.Q.2d 1241, 1246 (Fed. Cir. 1986). In other words, the Examiner has not explained why one skilled in the art would ignore the clear and unambiguous teachings of Schuermann that clearly indicate that the interrogation signal has a constant/same frequency, while the Examiner has instead chosen to isolate the teaching of Schuermann to “vary the duration” of the interrogation signal and has then combined this out-of-context teaching into the method of Kenny.

Based on the above, it is kindly requested that the rejection of claim 1 be withdrawn.

B. Discussion of the other independent claims

The other independent claims 12, 18-19, and 21 recite (using varying language), *inter alia*, “the second power being sent during a second time interval having a second length that is different than the first length of the first time interval,” and are amended herein to further recite “the first frequency of the first power being different from the second frequency of the second power.” These features are not disclosed, taught, or suggested by any of the cited references, whether singly or in combination.

For example, Kenny does not provide time intervals of different lengths. Schuermann does not provide different frequencies, and there is further no motivation or suggestion to combine the different techniques of Kenny and Schuermann. Thus, it is respectfully submitted that claims 12, 18-19, and 21 are allowable.

II. Conclusion

Overall, none of the references singly or in any motivated combination disclose, teach, or suggest what is recited in the independent claims. Thus, given the above amendments and accompanying remarks, the independent claims are now in condition for allowance. The dependent claims that depend directly or indirectly on these independent claims are likewise

allowable based on at least the same reasons and based on the recitations contained in each dependent claim.

If the undersigned attorney has overlooked a teaching in any of the cited references that is relevant to the allowability of the claims, the Examiner is requested to specifically point out where such teaching may be found. Further, if there are any informalities or questions that can be addressed via telephone, the Examiner is encouraged to contact the undersigned attorney at (206) 622-4900.

The Director is authorized to charge any additional fees due by way of this Amendment, or credit any overpayment, to our Deposit Account No. 19-1090.

All of the claims remaining in the application are now clearly allowable. Favorable consideration and a Notice of Allowance are earnestly solicited.

Respectfully submitted,

SEED Intellectual Property Law Group PLLC

/Dennis M. de Guzman/

Dennis M. de Guzman
Registration No. 41,702

DMD:wt

701 Fifth Avenue, Suite 5400
Seattle, Washington 98104-7092
Phone: (206) 622-4900
Fax: (206) 682-6031

882152_1.DOC